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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Robert Wilson et al.  
Serial No: 08/935,844  
Filed: September 23, 1997  
For: METHOD AND APPARATUS FOR IMPLEMENTING A REMOTE MIRRORING DATA FACILITY  
Examiner: McLean, K.  
Art Unit: 2185

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The undersigned hereby certifies that this document is being placed in the United States mail with first-class postage attached, addressed to Commissioner for Patents, Washington, D.C. 20231, on the 22nd day December 2000.

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Commissioner for Patents  
Washington, D.C. 20231

RESPONSE TO ADVISORY ACTION DATED 11/13/00

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In response to the Advisory Action dated November 13, 2000, Applicants respectively request reconsideration. The comments provided in the Advisory Action have been considered, but Applicants continue to believe that the pending claims are in allowable condition.

Initially, Applicants wish to thank Examiner McLean for her courtesy in granting and conducting a telephone interview on December 20, 2000. During the telephone interview, Applicants reiterated that if one of ordinary skill in the art were to follow the teachings of Zarrow and Yanai, they would arrive at a system configuration different than what is recited in Applicants' claims, specifically because the teachings of the prior art would lead to a system wherein the communication link between the storage systems is a point-to-point communication link. The Examiner indicated that she continued to disagree with this assessment, which prompted the undersigned to ask the Examiner to explain what system configuration she believed would result from the combined teachings of Zarrow and Yanai. The Examiner indicated that

she had not gone through the process of determining what actual system configuration she believes one skilled in the art would have been led to based upon the combined teachings of Zarrow and Yanai, and indicated that she did not believe that to be her burden in establishing a prima facie case of obviousness. The undersigned indicated disagreement with that position, and questioned whether it might help move the application to allowance if Applicants were able to cite authority indicating that the Examiner is required to determine what system configuration would result from combining the teachings of the prior art to properly set out a prima facie case of obviousness. The Examiner indicated that the citing of such authority might well have an impact on her decision that the pending claims are obvious under §103, and indicated that she would certainly be willing to consider any authority cited.

The Examiner's burden in setting forth a prima facie case of obviousness is set forth, for example, at MPEP §2142 (see page 2100-96), which states:

To reach a proper determination under 35 U.S.C. 103, the Examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. In view of all of the factual information, the Examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person. Knowledge of applicant's disclosure must be put aside in reaching this determination, yet kept in mind in order to determine the "differences," conduct the search and evaluate the "subject matter as a whole" of the invention. A tendency to resort to "hindsight" based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

Thus, the Examiner must go through a three step process: (1) the claim must be considered to determine the relevant field of the prior art and conduct the search; (2) the claim language must then be disregarded and the Examiner must look only to the teachings of the prior art in reaching a legal conclusion as to what one of ordinary skill in the art would have been motivated to arrive at based upon the collective teachings of the prior art ("impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art"); and (3) the claim must then be considered again and compared

against the combined teachings of the prior art to determine whether the claimed invention as a whole would have been obvious.

It is respectfully asserted that by failing to reach a conclusion as to what system configuration one of ordinary skill what have been led to based upon the teachings of Zarrow and Yanai, the requirement (2) above has not been met, as no conclusion was reached looking only to the teachings of the prior art. As indicated in the above-quoted portion of MPEP §2142, hindsight can only be avoided by ignoring Applicants' disclosure and claims, and looking solely to the teachings of the prior art to determine what those teachings would suggest. If the Examiner does not go through the process of determining what system configuration would result from the combined teachings of the prior art, the Examiner is impermissibly using the claim as a template to pick and choose certain isolated teachings of the references, without determining what the prior art teaches as a whole. See e.g., In re Fritch, 23 USPQ 2d 1780, 1784 (CAFC 1992) ("It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This Court has previously stated that '[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.'").

Applicants' position consistently has been that the teachings of the prior art would not result in the claimed invention, as the resulting system would have a point-to-point communication link between the storage systems, as that is what Yanai teaches. In the Advisory Action, the Examiner states that Yanai was relied upon:

... for the specific teaching of coupling a secondary storage system to a host CPU via a primary storage system and not for using a point to point communication link. Therefore, motivation to replace the direct point-to-point communication link in Yanai's system is not provided as feature was not relied upon. (Advisory Action, page 2).

Applicants respectfully assert that the above-quoted section of the Advisory Action makes clear that the Examiner is ignoring specific teachings in Yanai and not considering the reference as a whole, which is impermissible. (See e.g., MPEP §2142.02 at page 2100-95) ("A prior art reference must be considered in its entirety, i.e., as a whole, including portions that

would lead away from the claimed invention.”). The Federal Circuit and its predecessor court have repeatedly indicated that when performing an obviousness analysis under §103, each reference must be considered in its entirety to determine whether it fairly suggests that the invention as a whole is obvious. See e.g., Bausch & Lomb v. Barnes-Hind/Hydrocurve, 230 USPQ 416, 419 (Fed. Cir. 1986) (“it is impermissible within the framework of §103 to pick and choose from any one reference only so much of it as will support a given position to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one skilled in the art.”); In re Dow Chemical Co., 5 USPQ 2d 1529, 1531-1532 (Fed. Cir. 1988) (when determining whether a suggestion for the claimed invention can be found in the prior art, “the full field of the invention must be considered; for the person or ordinary skill is charged with knowledge of the entire body of technical literature, including that which might lead away from the claimed invention ... Evidence that supports, rather than negates, patentability must be fairly considered.”) (emphasis added); W.L. Gore & Associates, Inc. v. Garlock, Inc., 220 USPQ 303, 311 (noting that the District Court erred in its §103 analysis “in considering the references in less than their entireties, i.e., in disregarding disclosures in the references that diverge from and teach away from the invention at hand.”); In re Kuderna and Phillips, 165 USPQ 575, 578-579 (CCPA 1970) (stating that the issue of what would have been obvious to one of ordinary skill in the art must be made “in view of the *sum* of all the relevant teachings in the art, not in view of first one and then another of isolated teachings in the art.”); In re Wesslau, 147 USPQ 391, 393 (CCPA 1965) (reversing the Board’s decision and noting that if one were to follow the teachings of the prior art reference “in its entirety”, he would be led away from the Applicants’ invention).

The only teaching provided in the prior art of record for direct communication between two storage systems is Yanai’s teaching that a point-to-point communication link be employed. The Examiner has impermissibly ignored this teaching of Yanai, and thereby failed to consider the teachings of the reference as a whole. It is impermissible for the Examiner to rely upon one portion of Yanai without considering the reference as a whole. When considered in its entirety, Yanai teaches away from the claimed invention by specifically teaching that the communication link between the storage systems be a point-to-point communication link.

The Advisory Action asserts that Applicants have argued that “anyone using Yanai’s teachings would have only known to use a point-to-point communication link” and indicates that

the Examiner disagrees. (Advisory Action, page 2). That mischaracterizes Applicants' argument. What Applicants have argued is that Yanai specifically teaches the use of a point-to-point communication link, and nothing more. The Examiner has not cited any prior art reference that suggests modifying Yanai's point-to-point communication link for any reason.

The Advisory Action asserts that one of ordinary skill in the art would have known that Yanai's point-to-point communication link could be replaced with other types of links. (Advisory Action, page 2). However, the Advisory Action does not point to any motivation whatsoever in any prior art reference of record for making such a modification to the Yanai system. References can only be modified under §103 where there is some motivation in the prior art for making the modification. (MPEP §2143.01). Here, the prior art of record is devoid of any such motivation. Thus, it is respectfully asserted that no prima facie case of obviousness has been established.

As seen from the foregoing, a rejection under §103 clearly requires that the Examiner look only to the teachings of the prior art and consider all of the teachings of the prior art in making a determination as to whether the prior art renders the claim as a whole obvious. Here, the clear teachings of the prior art are to perform storage to storage communication over a point-to-point communication link as taught by Yanai. It is impermissible for the Examiner to disregard Yanai's specific teaching in this regard. In addition, to the extent that the rejection is based on the assertion that one of ordinary skill in the art would have been motivated to modify the point-to-point communication link of Yanai, there is simply nothing in the prior art of record to provide such a motivation. Therefore, it is respectfully asserted that no prima facie case of obviousness has been set forth.

In view of the foregoing, it is respectfully asserted that the claims as pending are in allowable condition for the reasons set forth in the amendment filed October 25, 2000, which is incorporated herein by reference. Therefore, a notice of allowance is respectfully requested. If the Examiner believes for any reason that the application is not in condition for allowance, she is respectfully requested to contact the undersigned to discuss any outstanding issues relating to the allowability of the application.

Respectfully submitted

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